

REMARKS

Rejection of Claims 1, 4, 8, 11, 12, 15, 16, 18, 28, 30, and 31 under 35 U.S.C. §102(e) over U.S. Patent No. 6,750,039 to Bargoot et al. ("Bargoot"):

This rejection is respectfully traversed because the Bargoot patent does not teach each and every limitation positively recited in the independent claims subject to this rejection (claims 1, 11, 28, and 31). As noted previously, independent claims 1 and 11 recite a system including a platform wherein the platform is configured to be "only" partially withdrawn from the container. Independent claim 28 includes a similar positive limitation. Claim 28 positively recites a system where the frame is "configured to be only partially withdrawn from said container." Independent claim 31 recites a cover "being adapted to remain in moveable connection to said frame." In short, each of the independent claims positively requires that the platform or cover be inseparable from the container or frame, respectively. The positive language of the claims is exclusionary. The word "only" as it appears in claims 1, 11, and 28 requires that the platform be present in one, and only one, condition: "partially withdrawn." A device such as Bargoot's, where the platform can be completely removed from the container, therefore does not fulfill the positive requirements of the claims. Therefore the rejection under 102(e) is improper and should be withdrawn.

In maintaining this rejection, the Office stated in the advisory action that "the platform of Bargoot can be configured to be partially removed from the container." But that is not what is required by the positive language of the present claims. Claims 1, 11, and 28 positively require that the platform is configured so that it is "only" partially withdrawn from the container. This simply is not taught in Bargoot. In Bargoot, the slide support 101 (shown in Fig. 1d) is specifically designed to be completely separable from the slide holder 103 shown in Fig. 3a because the slide support is intended to be "archived or disposed of." See Bargoot at column 7, lines 20-30. If the slid support 101 of Bargoot et al. was "only" partially withdrawn from the slide holder 103, that would frustrate the purpose of the Bargoot device. In that instance, to archive or dispose the slide support 101, both the slide support 101 and the slide holder 103 would have to be disposed.

Bargoot clearly and unambiguously states that slide support is purposefully designed to be completely removed from the slide holder. See Bargoot at column 9, lines 43-48:

At the completion of the incubation, the Slide Holder latches are released and the filter slide is removed from the assembly, placed in a standard slide tray, and placed in a wash solution at elevated temperature for 30 minutes after which the filter slide is analyzed in any commercially available imager or scanner, and the bacterial microcolonies are enumerated and the species of microorganism(s) is identified.

This passage explicitly states that the filter slide is removed entirely from the slide holder assembly. The present claims, however, require that the platform is configured to be "only" partially withdrawn from the container. This physical arrangement of elements, which is positively recited in all of the independent claims in the application, is nowhere described in the Bargoot patent.

Applicants therefore submit that the rejection of claims 1, 4, 8, 11, 12, 15, 16, 18, 28, 30, and 31 under §102(e) over Bargoot is untenable. Withdrawal of the rejection is respectfully requested.

Rejection of Claims 6, 7, 20 and 21 under 35 U.S.C. §103(a) over Bargoot in view of U.S. Patent No. 6,818,180 to Douglas et al.:

This rejection is traversed because the Bargoot device cannot be modified to arrive at the presently claimed invention without destroying the intended utility of the Bargoot device. It is well settled law that where a proposed modification destroys the intended utility of the device described in the applied prior art reference, a prima facie case of obviousness has not been established. See MPEP §2143.01(V) and the cases cited therein.

Specifically, all of the independent claims recite a system including a platform wherein the platform is configured to be "only" partially withdrawn from the container. Independent claim 31 recites a cover "being adapted to remain in moveable connection to said frame." In short, each of the independent claims positively requires that the platform or cover be inseparable from the container or frame, respectively. The positive language of the claims is exclusionary. The word "only" as it appears in claims 1, 11, and 28 requires that the platform be present in one, and only one, condition: "partially withdrawn." A device such as Bargoot's, where the platform can be completely removed from the container, therefore does not fulfill the positive requirements of the claims.

There is no motivation to alter Bargoot's device so that the filter slide is only partially withdrawn from the filter holder because Bargoot clearly and unambiguously states that the slide support is purposefully designed to be completely removed from the slide holder. See Bargoot at column 9, lines 43-48:

At the completion of the incubation, the Slide Holder latches are released and the filter slide is removed from the assembly, placed in a standard slide tray, and placed in a wash solution at elevated temperature for 30 minutes after which the filter slide is analyzed in any commercially available imager or scanner, and the bacterial microcolonies are enumerated and the species of microorganism(s) is identified.

This passage explicitly states that the filter slide is separated entirely from the slide holder assembly so that the filter carried on the slide support can be analyzed. The present claims, however, require that the platform is configured to be "only" partially withdrawn from the container. If Bargoot's device was modified to comply with this positive limitation of the claim, the utility stated in Bargoot would be destroyed: The slide support in Bargoot is purposefully dimensioned to fit into convention analytical equipment designed to handle "standard microscope slides." (Bargoot, column 9, lines third full paragraph.) If the filter slide could not be separated from the slide holder (which would be the required modification to meet the "only" limitation of the claims), Bargoot's filter slide would not fit into "any imager capable of accepting standard microscope slides." See Bargoot at column 9, lines 54-55. This is Bargoot's explicitly stated utility, and this utility would be completely destroyed by the modification to Bargoot proposed by the Office.

Combining Bargoot with Douglas does not cure the shortcomings of Bargoot because the combination of references still does not teach or suggest the claimed device. Douglas is cited solely for its description of using a barcode. So the combination of the two references yields Bargoot's device with Douglas' barcode. However, as noted above, Bargoot's device has to be impermissibly altered to arrive at the claimed device. Therefore, the combination of Bargoot with Douglas does not result in a *prima facie* case of obviousness. Therefore, this rejection is untenable. Withdrawal of the rejection of claims 6, 7, 20 and 21 under §103(a) over Bargoot in view of Douglas is respectfully requested.

Rejection of Claims 2, 5, 9, 10, 14, 22 and 23 under 35 U.S.C. §103(a) over Bargoot in view of U.S. Patent No. 6,818,180 to Douglas et al.:

This rejection is traversed because the Bargoot device cannot be modified to arrive at the presently claimed invention without destroying the intended utility of the Bargoot device. It is well settled law that where a proposed modification destroys the intended utility of the device described in the applied prior art reference, a prima facie case of obviousness has not been established. See MPEP §2143.01(V) and the cases cited therein.

Specifically, all of the independent claims recite a system including a platform wherein the platform is configured to be "only" partially withdrawn from the container. Independent claim 31 recites a cover "being adapted to remain in moveable connection to said frame." In short, each of the independent claims positively requires that the platform or cover be inseparable from the container or frame, respectively. The positive language of the claims is exclusionary. The word "only" as it appears in claims 1, 11, and 28 requires that the platform be present in one, and only one, condition: "partially withdrawn." A device such as Bargoot's, where the platform can be completely removed from the container, therefore does not fulfill the positive requirements of the claims.

There is no motivation to alter Bargoot's device so that the filter slide is only partially withdrawn from the filter holder because Bargoot clearly and unambiguously states that the slide support is purposefully designed to be completely removed from the slide holder. See Bargoot at column 9, lines 43-48:

At the completion of the incubation, the Slide Holder latches are released and the filter slide is removed from the assembly, placed in a standard slide tray, and placed in a wash solution at elevated temperature for 30 minutes after which the filter slide is analyzed in any commercially available imager or scanner, and the bacterial microcolonies are enumerated and the species of microorganism(s) is identified.

This passage explicitly states that the filter slide is separated entirely from the slide holder assembly so that the filter carried on the slide support can be analyzed. The present claims, however, require that the platform is configured to be "only" partially withdrawn from the container. If Bargoot's device was modified to comply with this positive limitation of the claim, the utility stated in Bargoot would be destroyed: The slide support in Bargoot is purposefully dimensioned to fit into convention analytical equipment designed to handle "standard

microscope slides." (Bargoot, column 9, lines third full paragraph.) If the filter slide could not be separated from the slide holder (which would be the required modification to meet the "only" limitation of the claims), Bargoot's filter slide would not fit into "any imager capable of accepting standard microscope slides." See Bargoot at column 9, lines 54-55. This is Bargoot's explicitly stated utility, and this utility would be completely destroyed by the modification to Bargoot proposed by the Office.

Combining Bargoot with Douglas does not cure the shortcomings of Bargoot because the combination of references still does not teach or suggest the claimed device. Douglas is cited solely for its description of optically detecting a reaction and storing the results on a ROM, RAM, or EEPROM. Thus, the combination of the two references yields Bargoot's device with Douglas' optical detection and digital storage. However, as noted above, Bargoot's device has to be impermissibly altered to arrive at the claimed device. Therefore, the combination of Bargoot with Douglas does not result in a *prima facie* case of obviousness. Therefore, this rejection is untenable. Withdrawal of the rejection of claims 2, 5, 9, 10, 14, 22 and 23 under §103(a) over Bargoot in view of Douglas is respectfully requested.

CONCLUSION

Applicant submits that the application is now in condition for allowance. Early notification of such action is earnestly solicited.

The Commissioner if authorized to charge any fees or credit any overpayments relating to this application to Deposit Account No. 18-2055.

Respectfully submitted,

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I certify that this paper is being electronically submitted to the U.S. Patent and Trademark Office via the PAIR (Patent Application Information Retrieval) system on the following date:

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Signature: /Jos. T. Leone/